

REMARKS

By this Reply, Applicants amend claims 1, 4-7, 9, 10, and 13-16. Claims 1-18 are pending in this application.

In the Office Action, the Examiner took the following actions:

rejected claim 10-18 under 35 U.S.C. § 101 as allegedly being drawn to non-statutory subject matter; and

rejected claims 1-18 under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent Application Publication No. 2005/0086204 to Coiera et al. (*Coiera*) in view of U.S. Patent No. 7,448,046 to Navani et al. (*Navani*).

I. REJECTION UNDER 35 U.S.C. §101

Applicants respectfully traverse the rejection of claims 10-18 under 35 U.S.C. §101. The Office Action alleges that each of claims 10-18 would include a medium that is propagated signals. Even though Applicants do not agree with the Office Action's allegation, to expedite prosecution Applicants have amended the specification to expressly recite "an article comprising a **tangible** machine-readable medium" (emphasis added) (Paragraph [0007]). One of ordinary skilled would understand the originally described and claimed machine - readable medium - includes a tangible component, and does not include propagated signals. Therefore, these claims are statutory under 35 U.S.C. §101 and their rejection should be withdrawn.

II. REJECTION UNDER 35 U.S.C. §103

Applicants respectfully traverse the rejections of claims 1-18 under 35 U.S.C. § 103(a) as being unpatentable over *Coiera* in view of *Navani*. A *prima facie* case of obviousness has not been established.

The key to supporting any rejection under 35 U.S.C. § 103 is the clear articulation of the reason(s) why the claimed invention would have been obvious. See M.P.E.P. § 2142, 8th Ed., Rev. 6 (Sept. 2007). Such an analysis should be made explicit and cannot be premised upon mere conclusory statements. See *id.* “A conclusion of obviousness requires that the reference(s) relied upon be enabling in that it put the public in possession of the claimed invention.” M.P.E.P. § 2145. Furthermore, “[t]he mere fact that references can be combined or modified does not render the resultant combination obvious unless the results would have been predictable to one of ordinary skill in the art” at the time the invention was made. M.P.E.P. § 2143.01(III), internal citation omitted. Moreover, “[i]n determining the differences between the prior art and the claims, the question under 35 U.S.C. § 103 is not whether the differences themselves would have been obvious, but whether the claimed invention as a whole would have been obvious.” M.P.E.P. § 2141.02(I), internal citations omitted (emphasis in original).

“[T]he framework for the objective analysis for determining obviousness under 35 U.S.C. 103 is stated in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966). . . . The factual inquiries . . . [include determining the scope and content of the prior art and] . . . [a]scertaining the differences between the claimed invention and the prior art.” M.P.E.P. § 2141(II). “Office personnel must explain why the difference(s) between the

prior art and the claimed invention would have been obvious to one of ordinary skill in the art.” M.P.E.P. § 2141(III).

Amended independent claim 1 recites a method including “locating a second resource of the at least one resource, the second resource failing to match the set of constraints defined in the resource template, wherein the second resource is related to the set of attributes defined in the resource template” and “using a process modeling tool to monitor a status of the first resource, second resource, and the step of the business workflow.” *Coiera* and *Navani*, taken individually or in combination, do not teach or suggest at least these claimed features.

Coiera discloses a “searching system [...] to facilitate an accurate and comprehensive search.” (Paragraph [0003]). In *Coiera*, “search templates” are used to “include key words [to] **limit[]** the search” (emphasis added). (Paragraph [0009]-[0012]). *Coiera* further discloses that “[b]y typing a word or phrase [...], the search will **exclude all** sources containing this word phrase” (emphasis added). (Paragraph [0060]). That is, in *Coiera*, any searches returned by the system are within the limitations defined in the search templates. *Coiera*, therefore, does not teach or suggest “the second resource **failing to match the set of constraints defined in the resource template**, wherein the second resource is related to the set of attributes defined in the resource template,” as recited in claim 1 (emphasis added).

Additionally, *Coiera* merely describes searching using keywords, as described above; however, the reference fails to even mention a “process modeling tool,” as recited in claim 1. Therefore, even if *Coiera* were to “locat[e] a second resource, the second resource failing to match the set of constraints defined in the resource template,

wherein the second resource is related to the set of attributes defined in the resource template,” *Coiera* still would not teach or suggest “using a process modeling tool to monitor a status of the first resource, second resource, and the step of the business workflow,” as further recited by claim 1.

Navani does not compensate for any of the above-discussed deficiencies of *Coiera*. The Office Action alleges that *Navani* teaches “wherein a process modeling tool enables creation of new business workflow and collaborative workflow within an enterprise management system.” (Office Action at page 4). Even if this allegation is correct, which Applicants do not concede, *Navani* still would not teach or suggest any of “locating a second resource, the second resource failing to match the set of constraints defined in the resource template, wherein the second resource is related to the set of attributes defined in the resource template” and “using a process modeling tool to monitor a status of the first resource, second resource, and the step of the business workflow,” as recited in claim 1. Therefore, *Coiera* and *Navani*, taken individually or in combination, do not teach or suggest all of the elements of claim 1.

In view of the above, the Office Action has not properly determined the scope and content of the prior art nor properly ascertained the differences between the prior art and the claimed invention. Accordingly, the Office Action has failed to clearly articulate a reason why the claim would have been obvious to one of ordinary skill in view of the references. Therefore, a *prima facie* case of obviousness has not been established for independent claim 1 and the rejection under 35 U.S.C. § 103(a) should be withdrawn.

Independent claim 10, while differing in scope than claim 1, recites elements similar to those of claim 1 that were discussed above. Therefore, the Examiner should also withdraw the rejection of claims 10 under 35 U.S.C. § 103(a).

Claims 2-9 and 11-18 depend either directly or indirectly from independent claims 1 and 10. Accordingly, the rejection of claims 2-9 and 11-18 should be withdrawn at least due to this dependence.

CONCLUSION

In view of the foregoing amendments and remarks, Applicants respectfully request reconsideration and reexamination of this application and the timely allowance of the pending claims.

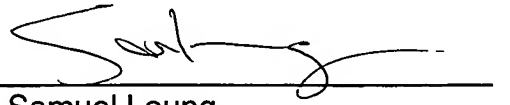
Please grant any extensions of time required to enter this response and charge any additional required fees to our deposit account 06-0916.

Respectfully submitted,

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Dated: February 20, 2009

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